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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,011	02/12/2001	David Leigh Donoho	UNIV0001D2-C	2182

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GLENN PATENT GROUP  
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EXAMINER
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CHOUDHURY, AZIZUL Q

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/782,011	<b>Applicant(s)</b> DONOHO ET AL.	
	<b>Examiner</b> Azizul Choudhury	<b>Art Unit</b> 2145	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 January 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 5, 7, 9-12 and 20-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 7, 9-12 and 20-2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/23/06</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This action is responsive to the amendment of the applicant, filed on 1/4/06. Claims 1, 5, 7, 9-12 and 20-28 are presented. The current examiner fully accepts the search and examination provided by the previous examiner of record, in charge of the application.

#### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1, 5, 7, 9-12 and 20-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1,5 and 20-28 disclose an inspector, which includes an inspector library having special purpose executable code. The inspector and the inspector library are not tangibly limited to a physical product. Claims 7 and 9-12 disclose an inspector library containing executable code. The inspector library is not tangibly limited to a physical product. Therefore, claim 1, 5, 7, 9-12 and 20-28 are not tangibly embodied.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 5, 7, 9-12 and 20-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Ahmad, USPN 6,029,258.

5. Regarding claim 1, Ahmad discloses a method for inspecting any of the properties of a consumer's computer, the computer's configuration, contents of the computer's storage devices, the computer's peripherals, the computer's environment, or remote affiliated computers, comprising the steps of: providing at least one inspector which includes an inspector library having special purpose executable code [Ahmad, col. 7, line 59 – col. 8, line 26 and col. 10, lines 30-43]; and evaluating subexpressions with the at least one inspector [Ahmad, col. 8, lines 19-26]; wherein the inspector performs any of mathematic-logical calculations, executes computational algorithms, returns the results of system calls, accesses the contents of storage devices, and queries devices [Ahmad, col. 8, lines 27-49 and col. 9, lines 44-63], wherein said inspector automatically evaluates a database of advise for relevance to said consumer's computer by use of an automated advise reader, wherein said advise reader operates in the absence of consumer involvement [Ahmad, col. 2, lines 4-8 and col. 13, lines 9-12].

6. Regarding claim 5, Ahmad further discloses sending certain relevance clauses to a remote location; evaluating the clauses; and returning the clauses after a user is

made aware of what is being transferred; wherein properties of the remote location are learned [Ahmad, col. 6, lines 36-67 and col. 9, lines 44-63].

7. Regarding claim 7, Ahmad further discloses a computer implemented inspector for inspecting any of the properties of a computer, said computer's configuration, contents of said computer's storage devices, said computer's peripherals, said computer's environment, or remote affiliated computers, said inspector comprising: an inspector library containing executable code, which is invoked as part of a continual relevance evaluation process [Ahmad, col. 7, line 59 – col. 8, line 26 and col. 10, lines 30-43]; and one or more automatic unattended inspector methods for performing any of mathematic-logical calculations, executing computational algorithms, returning the results of system calls, accessing the contents of storage devices, and querying devices or remote computers [Ahmad, col. 2, lines 4-8 and col. 17, lines 9-12], wherein a one way membrane allows said inspector methods to view a relevant advisory without divulging user's identity [Ahmad, col. 7, line 69 – col. 8, line 26 and col. 10, lines 30-43; user identity is not obtained from the user's machine in Ahmad's design]

8. Regarding claims 20-22, Ahmad further discloses the inspector resides at the consumer's computer, wherein invoking the inspector with an advice reader running on the consumer's computer, accessing the special purpose executable code using the advice reader [Ahmad, col. 7, line 59 – col. 8, line 26 and col. 10, lines 30-43].

9. Regarding claim 23, Ahmad further discloses installing at least a portion of contents of the inspector library at run-time [Ahmad, col. 8, lines 3-49].

10. Regarding claims 24-27, Ahmad further discloses delivering advisories from an advice provider to the consumer's based upon results from the at least one inspector, wherein an advice provider delivering information from a plurality of advice providers, wherein information about a consumer does not transfer from the consumer's computer unless the consumer initiates the transfer and dynamically updating a collection of the inspector libraries [Ahmad, col. 7, line 59 – col. 8, line 26, col. 10, lines 30-43 and col. 16, line 52 – col. 17, line 9].

11. Regarding claim 28, Ahmad further discloses the step of inspecting using the at least one inspector any of: version, operating system, registry, preferences, and a database [Ahmad, col. 9, lines 44-63].

12. Regarding claims 9-12, the claims 9-12 have similar limitations as claims 1, 5 and 20-28. Therefore, the similar limitations are disclosed under Ahmad for the same reasons set forth in the rejection of claims 1, 5 and 20-28 [Supra 1, 5 and 20-28].

### ***Response to Arguments***

The amendment received on January 4, 2006 has been carefully examined but, is not deemed fully persuasive. The amendment consisted of claim amendments along

with remarks. The office action has been revised to cite pertinent portions of the prior art for the amended claims. The following explanations address the concerns expressed within the remarks portion of the amendment.

Despite claim amendments, claim 1, 5, 7, 9-12 and 20-28 continue to fail overcoming the 101-type rejection issued. The addition of the phrase "computer implemented," does not make a software/program tangible. Software and programs are not patentable material by themselves.

As for the 112-type rejection, the claim amendments have overcome this rejection.

As for the double-patenting rejection, the proper submission of a terminal disclosure has overcome this rejection.

As for claims 1 and 12, the claims have been amended to feature an automatic inspector. The examiner cites col. 2, lines 4-8 and col. 13, lines 9-12 within the Ahmad reference in response to this amendment. Within those portions, it is taught how the TSP is able to retrieve information without input from the user.

As for claim 7, the claim has been amended to feature a "one way membrane" which allows the inspector to view advisory without divulging the user's identity. Within col. 7, line 69 – col. 8, line 26 and col. 10, lines 30-43 of Ahmad's disclosure, information is obtained however user identity is not obtained from the user's machine in Ahmad's design.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Azizul Choudhury whose telephone number is (571) 272-3909. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AC

  
JASON CARDONE  
SUPERVISORY PATENT EXAMINER